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EXAMINER

ROBERT, EDUARDO C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,679

Applicant(s)

CUMMING, J. STUART

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 53-98 is/are pending in the application.
- 4a) Of the above claim(s) 58,60,62,64-72,75-89 and 91-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-57,59,61,63,73,74 and 90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5,6,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of Species IX, i.e. Figure 18, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement for the different Species, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

Also, it is acknowledged that applicant believes claims 53-59, 61, 63, 65, 73-74, 77, 80, 81, 85, and 90-94 read on the elected Species IX, i.e. Figure 18, and that claims 53, 85 and 90 are generic claims. It is noted that comparison of the claims with Figure 18 and the specification shows, however, that the Species of Figure 18 does not have a hinge being a flexible portion of the haptic as required by claim 58, or at least a portion of the haptic outer end having a thickness greater than the haptic inner end as required by claim 77 (claim 77 appears to be directed to non-elected Species VIII, Figures 16, 17), or a hinge interconnecting the haptic outer portion and the haptic inner portion as required by claim 80, or the haptics having a hinge between their respective inner and outer ends as required by claim 91. It is noted that the Species of Figure 18 (which is similar to the lens 32) has a lens body 33 of rectangular shape with an optical zone 34, plate haptics 36 extending from the optic and hinges 38 **which join the inner ends of the haptics to the optic** (see applicant's specification page 33, lines 13, and page 44, lines 16-19). Thus, clearly the hinge is not part of the haptic and it is not between an inner portion of the haptic and an outer portion of the haptic.

Furthermore, claim 65 does not read on the elected Species since it depends from claim 64 which, according to applicant, does not read on the elected Species. Claims 81 and 85 do not read on the elected Species because they depend from claim 80 which does not read on the elected Species (see explanation above) and claims 92-94 do not read on the elected Species since they depend from claim 91 which does not read on the elected Species (see explanation above).

Claims 53 and 90 are generic claims.

Claims 58, 60, 62, 64-72, 75-89, and 91-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Species, there being no allowable generic or linking claim. Election was made with traverse in Paper No. 8, however, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement for the different Species, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

The requirement is therefore made FINAL.

### ***Drawings***

The drawings are objected to because they do not include certain reference signs mentioned in the description. 37 CFR § 1.84(f) states, "Reference signs not mentioned in the description shall not appear in the drawing and vice versa." The following reference sign is not included in the drawings: 33. Correction is required.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and

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b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and may not be deferred.

### *Specification*

The continuing date at the beginning of the specification should be updated to reflect the current status of each application.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 53, line 2, "the ciliary muscle" and "the human eye" each lacks a prior antecedent.

In claim 90, line 2, "the ciliary muscle" lacks a prior antecedent. In line 4, "normally" is indefinite because it is unclear what applicant means by "normally".

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,197,059, over claims 1-8 of U.S. Patent No. 5,476,514, and over claims 1-42 of U.S. Patent No. 5,647,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patents '059, '514, and '282 lies in the fact that the patent claims includes more elements and are more specific. Thus, the invention of the patent claims are in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the application are anticipated by the claims of the patents '059, '514, and '282, they are not patentably distinct from the claims of the patents.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennant (Reference U.S. Pat. 4,254,509 on PTO-1449).

Tennant discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (Reference U.S. Pat. 4,424,597 on PTO-1449).

Schlegel discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (Reference U.S. Pat. 4,673,406 on PTO-1449).

Schlegel discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic. The bulge and/or notches 16 are considered the fixation means.

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kalb (Reference U.S. Pat. 4,585,457 on PTO-1449)

Kalb discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic having an optic axis, and a plurality of extended portions extending generally radially out from the optic. Each of extended portions having inner ends joined to opposite sides

of the optics and opposite outer ends. The extended portions are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Portnoy (Reference U.S. Pat. 4,759,761 on PTO-1449).

Portnoy discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic having an optic axis, and a plurality of extended portions extending generally radially out from the optic. Each of extended portions having inner ends joined to opposite sides of the optics and opposite outer ends. The extended portions are movable anteriorly and posteriorly relative to the optic. It is noted that one of optics embodiment of Portnoy has the posterior surface convexly curved to a substantially steeper convex curvature than the anterior surface (see Figure 2b).

### ***Conclusion***

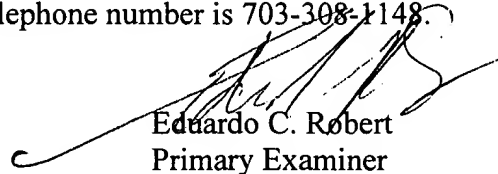
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C. Robert  
December 30, 2002